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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,205

03/26/2004

Paula Klecka

PK-101

1967

7590

07/11/2005

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/811,205

Applicant(s)

KLECKA, PAULA

Examiner

David C. Reese

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment: 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 5/23/2005.

Status of Claims

- [1] Claims 1-24 are pending.

Drawings

- [2] The drawing(s) were previously objected for informalities. In view of Applicant's amendment to the drawing(s)/replacement drawing(s) submitted on 5/23/2005, all previous objection(s) to the drawings have been withdrawn. Accordingly, the changes have been entered.

Specification

- [3] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 5/23/2005. Accordingly, the objection(s) to the specification and abstract have been withdrawn and the abstract entered.

Claim Rejections - 35 USC § 112

- [4] The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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[5] Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 states, “further comprising: a second additional seat; a second additional gemstone; and a second shared prong.” In Claim 1, however, two seats and two gemstones have already been claimed. It appears that instead of using the term “second” in Claim 3, this should be changed to “third,” with the last line of the claim being changed as well to reflect the change in the first three lines.

Claim Rejections - 35 USC § 102

[6] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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[7] Claims 1-4, 6, 9-10, 12-14 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Vitau, US- 4,292,818, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Vitau is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Vitau teaches of an article of jewelry (Fig. 2B/3B) including two or more gemstones (Fig. 3c), the article comprising:

- a seat (10)-

- a gemstone (S) positioned on the seat (10);

- two prongs positioned one on each side of the gemstone (first and second 22/23 in the top row, the gemstone second from the left in the top row), each prong of the two prongs (22 in Fig. 3C) having a bezel formed therein (22/23 in Fig. 3C), the gemstone (S) retained within the bezel (S in the notch slightly between 22 and 23 in Fig. 3C);

- an additional seat (third seat from the left);

- an additional gemstone positioned on the seat (S) positioned on the additional seat (third seat from the left);

- two additional prongs (second and third 22/23 in the top row of Figs. 2A/3A and 2B/3B) positioned one on each side of the additional gemstone (the multiple 5 surrounding each gemstone in Fig. 1), each prong of the two additional prongs having a bezel formed therein (the

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notch at the intersection of 22 and 23), the additional gemstone retained within the bezel (S in the notch at the intersection between 22 and 23 in Fig. 3C), and

a shared prong positioned between the gemstone and the additional gemstone (the second 22/23 in Figs. 2A/3A and 2B/3B), the shared prong having a bezel formed on each side to partially engage with a respective inner edge of the gemstone and the additional gemstone (the second S in Fig. 3C the girdle of which is retained under the notches of the first and second 22/23), the article of jewelry including an exposed and unbound outer edge of the gemstone (the second gemstone placement in Fig. 2A/3A whereby the entire upper side of the gemstone is exposed and unbound) and an exposed and unbound outer edge of the additional gemstone (the third gemstone placement from the right in Fig. 2A/3A whereby the entire upper side of the gemstone is exposed and unbound), each exposed and unbound outer edge opposite the shared prong (the second 22/23 in Fig. 2A/3A) and the respective inner edge (any inner edge) and freely extending between the two prongs (22/23) or between the two additional prongs (22/23).

As for Claim 2, wherein the seat includes a conical taper that engages with the gemstone (12 in Fig. 1B).

As for Claim 3, further comprising:

a second additional seat (fourth seat from the top left in Fig. 2A/3A);

a second additional gemstone positioned within the seat (fourth S in Fig. 2A/3A); and

a second shared prong (the third 22/23 in Fig. 2A/3A) positioned between the additional gemstone (third S in Fig. 2A/3A) and the second additional gemstone (Fourth S in Fig. 2A/3A) and forming a negative space (20) between the gemstones (S).

As for Claim 4, further comprising:

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an array of additional seats (seats on the bottom row of Figs. 2A/3A and 2B/3B);
a corresponding array of additional gemstones positioned within the respective seats (S in the seats on the bottom row of Figs. 2A/3A and 2B/3B), each additional gemstone (S) of the array of additional gemstones positioned between two prongs (22/23 of the bottom row); and
a shared prong (22/23) positioned between each additional gemstone (S) of the array of additional gemstones so that each gemstone along an outer edge of the article of jewelry includes an exposed outer edge (bottom of each S placed on the bottom row).

As for Claim 6, wherein the array of additional gemstones are formed in a lattice (3A).

As for Claim 9, Vitau teaches of a article of jewelry, comprising:

a plurality of gemstones (S), each gemstone of the plurality of gemstones (S) positioned in a seat (10);

a pair of prongs (22/23) positioned one on each side of each gemstone (S);

a shared prong (22/23) positioned between each gemstone (S); and

each gemstone (S) positioned at a peripheral edge of the article of jewelry including an exposed outside edge (top, bottom, left or right of gemstone depending on which row and gemstone one refers to) freely extending between the pair of prongs (22/23).

As for Claim 10, wherein the seat comprises a tapered ring (10).

As for Claim 12, wherein at least three of gemstones (S) form a negative space (20) between the gemstones (in Fig. 2A).

As for Claim 13, wherein each prong of the pair of prongs (22/23) includes a bezel formed along an inside edge of the prong (at the intersection of 22 and 23), an edge of the gemstone (S) fitting within the bezel (as shown in Fig. 3C).

As for Claim 14, wherein the shared prong (22/23) includes a pair of bezels formed along each of two opposite sides of the shared prong (at the intersection of both 22 and 23, as well as on both sides as shown in Fig. 3C) the pair of bezels accommodating inner edges of adjacent gemstones of the plurality of gemstones (S).

Claim Rejections - 35 USC § 103

[8] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[9] Claims 15-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Vitau, US-4,292,818.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 15, Vitau teaches of a setting and method for mounting precious stones comprising:

a plurality of gemstones aligned in a row (S in 10 in the first row in Fig. 2A);

a pair of prongs (22/23 in Figs. 2A and 3A), each prong of the pair of prongs positioned on opposite sides of each gemstone of the plurality of gemstones (S); and

a shared prong positioned between each gemstone in the row (22/23 in Figs. 2A and 3A), so that an outer edge of each outer gemstone in the row is exposed (top outer edge of S) and freely extends between the pair of prongs (22/23).

The difference between the claim and Vitau is the claim recites: that the pluralities of gemstones are maintained in a ring. Examiner takes official notice that it is old and well known, obvious, and a matter of art recognized equivalence, to use a random gemstone setting and submit it into various jewelry items such as a ring, pendant, or necklace, or earring. In this case especially because there is nothing further being disclosed or claimed regarding the exact structure of the ring; it is primarily being used as a platform for the introduction of the instant gemstone setting. The prior art is saturated with different settings interchangeable within pendants, necklaces, earrings, rings, etc. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have inputted the gem setting and method for mounting precious stones as taught by Vitau to also incorporate an embodiment whereas such a setting can be used within a plurality of jewelry items including that of a ring (also see Ouzounian and Hoffman).

As for Claim 16, further comprising:

a second row of a second plurality of gemstones positioned adjacent the row (the second row below the first in Figs. 2A and 3A).

As for Claim 17, further comprising:

a third row of a third plurality of gemstones positioned adjacent the second row (the third row in Figs. 4A and 5A).

As for Claim 18, wherein the plurality of gemstones are formed in an array (Figs. 2A and 3A).

As for Claim 19, wherein the array forms a lattice (Figs. 2A and 3A) and a negative space between the gemstones (20).

As for Claim 20, wherein the array forms a lattice is one of generally planar along one face of the ring (1' is planar) and curved around a circumference of the ring (Figs. 2A and 3A are curved).

As for Claim 21, Vitau teaches of a gemstone presentation comprising:

a plurality of gemstones (S) aligned in a row;

a pair of prongs (22/23), each prong of the pair of prongs positioned on opposite sides of each gemstone of the plurality of gemstones (S); and

a shared prong (22/23) positioned between each gemstone (S) in a row, so that each adjacent pair of gemstones (S) is at least partially retained by the shared prong (22/23), and each gemstone (S) along an outer edge of the aligned gemstones having an exposed and unbound outer edge (top, bottom, left or right of gemstone depending on which row) opposite the shared prong (22/23) and extending freely between the pair of prongs (22/23).

As for Claim 22, further comprising:

a second row of a second plurality of gemstones positioned adjacent the row (the second row in either 2A and 3A or 4A and 5A).

As for Claim 23, further comprising:

a third row of a third plurality of gemstones positioned adjacent the second row (the third row in Figs. 4A and 5A).

As for Claim 24, wherein the plurality of gemstones (S) are formed in an array (Figs. 2A and 3A) so that adjacent pairs of gemstones (S) share the shared prong (22/23) and a negative space (20) is formed between the gemstones (S).

Claim Rejections - 35 USC § 103

[11] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[12] Claims 5, 7-8, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitau, US- 4,292,818.

Vitau discloses the claimed invention except for stating that the array of multiple gemstones and their respective holding means can be found respectively: in a ring shape, positioned on a ring, and positioned on a pendant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape or order of the multiple gemstones while maintaining their specific design, as well as manipulating the substrate by which this array is housed in. These are common ways to display gemstones as readily

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appreciated by anyone familiar in the art, as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

[13] All arguments are considered moot in view of new grounds of rejection. Examiner would also like to direct the applicant's attention to the following additional patents that were found with additional search that have extreme relevance to the instant case, the patents primarily focusing on the exact structure of the position of the gemstones. Take, for example, the following patents: Pinto et al., US-D498,169; Pinto et al., US-D499,046; Anderson, US-D405,026; Tirakian, US-D427,933; Kurylo, US-D455,670; Meyers, D42,643; Maynier, US-2,132,905.

Conclusion

[14] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[15] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

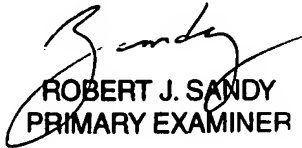
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR



ROBERT J. SANDY
PRIMARY EXAMINER